REMARKS

Applicants elect Group I drawn to the embodiment of a polymer composition. In addition, pursuant to the restriction/election requirement of a fluoropolymer, Applicants elect the cyclic fluorocarbon oxygen containing polymer. Further, pursuant to restriction/election of species requirement, Applicants elect claims 1, 2, 9-12, and 16-19 from Group I. The election is made with traverse.

Traversing Restriction/Election of Fluoropolymer in the Markush Group

The Office Action alleges that claims of Group I (claims 1, 2, 9-12, 13-15, and 16-19) are directed to patentably distinct species of fluoropolymer. *See Office Action of February 16, 2006, pg. 1, ¶ 4, ll. 1-4.* The alleged species include a cyclic fluorocarbon oxygen containing polymer, a polyimide linear fluoropolymer, and a perfluorinated polyether as listed in the Markush-type claims 2, 13, and 16. However, the Office Action fails to expressly require the election of a member of the amorphous fluoropolymers from the Markush group. The Notice of Noncompliant response of March 30, 2006 does state that the restriction/election of fluoropolymer is required. Applicants respectfully traverse this restriction/election requirement of fluoropolymer from the Markush group.

Under MPEP § 803.02, the Examiner must examine all members of the Markush group in the present application.

> **If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without**

> **serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions.** In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species.
>
> Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.** *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). **Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.** (Emphasis Added)

The members of the Markush group in claims 2, 13, and 16 are sufficiently few in number and are closely related. All members of the Markush group are amorphous fluoropolymers. For example, claim 2 expressly recites that the members of the Markush group are "amorphous fluoropolymers," and the specification supports this at least on ¶ [0017].

Further, the above test for unity of invention under MPEP § 803.02 weighs in favor of examining all members of the Markush group in this application. Because all members of the Markush group are amorphous fluoropolymers, the members (1) share a common utility directed to fluorination of PVDF, which can improve both transmission and durability of the fluorinated PVDF. This shared utility among all members of the Markush group is made possible because all members (2) share a substantial structural feature, fluorine containing polymer,

essential to that utility. Applicants expressly disclose the use of amorphous fluoropolymers to fluorinate PVDF at least on ¶ [0018]. Therefore, Applicants respectfully request the Examiner withdraw the restriction/election requirement of fluoropolymer and examine all members of the Markush group.

Rejoinder under MPEP § 821.04

The Office Action of February 16, 2006 fails to advise that Applicants are entitled to rejoinder of process claims upon an election of the group drawn to product claims. As specified in MPEP § 821.04, when an election is made to a group drawn to product claims, Applicants are entitled to rejoinder of all process claims which recite all features of the product claims. *See, MPEP § 821.04.*

> Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f)(f) and 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c)(c) and 821 through 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Accordingly, Applicants reserve the right to rejoinder of all process claims 3-8 if the elected product claims are subsequently found allowable.

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Serial No. : 10/799,928
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Page : 5 of 5

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Respectfully submitted,

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